Request For Rehearing Under 37 C.F.R. § 41.52(a)(1)
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Dated: May 18, 2009 Signature: Donna Dobson
(Donna Dobson)

Docket No.: 50715/P004US/10311738
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
F. C. Greer et al.

Application No.: 10/662,992

Confirmation No.: 2249

Filed: September 15, 2003

Art Unit: 1793

For: PROCESS FOR THE PRODUCTION OF METAL FLUORIDE MATERIALS

Examiner: N. Y. M. Nguyen

REQUEST FOR REHEARING UNDER 37 C.F.R. 41.52(A)(1)

Board of Patent Appeals and Interferences
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Madam:

Appellant respectfully requests that the Board of Patent Appeals and Interferences (the "Board") grant a rehearing in appeal number 2009-1401 and modify the decision issued March 31, 2009 in light of the following remarks.

BRIEF SUMMARY OF ACTIONS

The present application was filed September 15, 2003. Claims 1 – 34 as originally presented were subjected to a Restriction Requirement mailed October 11, 2006. In response, Appellant traversed the restriction requirement with no amendment to the claims. A non-final Office Action was mailed February 7, 2007 rejecting claim 1 – 34. In response, Appellant submitted an Amendment dated May 4, 2007 amending claims 1, 7, 9, 13, 14, 21, 24, 25, 27 – 32 and 34. In response to a final Office Action mailed July 13, 2007 rejecting claim 1 – 34, Appellant submitted a Notice of Appeal on October 10, 2007 followed by an Appeal Brief dated December 10, 2007. Appellant further submitted a Reply Brief dated May 14, 2008 in response to the Examiner's Answer mailed March 14, 2008.

The Board issued a Decision on Appeal dated March 31, 2009 making certain findings of fact, affirming rejections of claims 1 – 34 made by Appellee. Appellant files this Request for Rehearing within two months of the Board's decision, as provided in 37 C.F.R. § 41.52(a)(1).

REMARKS

I. Points for Rehearing by the Board

Claims 1 – 34 stand rejected under 35 U.S.C. § 103(a) as obvious over the combined teachings of U.S. Patent No. 4,034,070 to Wojtowicz et al. (hereinafter "Wojtowicz"), U.S. Patent No. 4,938,945 to Mahmood et al. (hereinafter "Mahmood"), and U.S. Patent No. 5,286,882 to Zuzich et al. (hereinafter "Zuzich"). The points misapprehended or overlooked by the Board relating to these rejections are discussed below.

A. The Board did not consider the differences between the claims and Zuzich

The Board did not consider the differences between the claims and the Zuzich reference. In an obviousness rejection, "[u]nder § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved." *Graham v. John Deere Co.*, 383 U.S. 1, 15 – 17 (1966) (emphasis added). In the current case, the Board did not consider that the reactants and products in the Zuzich reference are different from the reactants and products of the claims. Zuzich teaches a reaction for preparing polyethercyclicpolyol by heating an alkali or alkaline earth metal hydroxide with a polyol and epihalohydrin or epoxy alcohol while the rejected claims involve a reaction between anhydrous hydrofluoric acid and anhydrous metal. Further, the Zuzich reference discloses an exothermic reaction while the claims require an endothermic reaction. The Appellant has highlighted these differences between Zuzich and the claims and asserted that these differences make it improper to use Zuzich for teaching limitations of the rejected claims. *See e.g.* Reply Brief, pages 5 – 6.

Instead of addressing the differences between the Zuzich reference and the claims, the Board summarily notes that the Appellee relies on Zuzich for particular teachings only: "Mahmood and Zuzich were cited for teaching controlled addition of reactants." Board

Decision, page 9, n.3. However, in an obviousness rejection, the references must be considered for all that it teaches. *Ashland Oil, v. Delta Resins & Refracs, Inc.*, 776 F.2d 281, 296 (Fed. Cir. 1985) ("A reference, however, must have been considered for all it taught, disclosures that diverged and taught away from the invention at hand as well as disclosures that pointed towards and taught the invention at hand.") In the current case, the Board, by focusing only on a particular asserted teaching of Zuzich without considering the differences between the claims and Zuzich, has denied the Appellant a proper obviousness analysis of the rejected claims. Because the Board has overlooked the differences between the claims and Zuzich, the Appellant respectfully submits that a rehearing of the current appeal is required.

B. The Board did not consider the differences between the claims and Mahmood

The Board has also ignored an important difference between Mahmood and the claims. Consideration of the differences between the claims and the references is fundamental to a proper obviousness analysis. *See Graham* 383 U.S. at 15 – 17. In the current case, the claims require adding anhydrous metal to anhydrous hydrofluoric acid. In contrast, Mahmood teaches adding hydrofluoric acid to a metal compound—the opposite of that required by the claim. Because of this difference, the Appellant asserted that the Appellee cannot rely on Mahmood to teach adding anhydrous metal to anhydrous hydrofluoric acid in intervals when Mahmood does not even teach adding anhydrous metal to anhydrous hydrofluoric acid. *See* Reply Brief, page 5. In other words, the Appellee cannot rely on the asserted "adding in intervals" teaching of Mahmood without a consideration of which reactant is being added to the other reactant.

Instead of considering the difference between Mahmood and the claims, the Board summarily adopts the position of the Appellee that Mahmood is only being considered for particular teachings: "Mahmood and Zuzich were cited for teaching controlled addition of reactants." Board Decision, page 9, n.3. However, in an obviousness rejection, the references must be considered for all that it teaches. *Ashland Oil,* 776 F.2d 281 at 296. In the current case, the Board has simply overlooked the differences between Mahmood and the claims and thereby denied Appellee a proper obviousness analysis as required by *Graham.*

C. Summary

In sum, the Board has ignored the differences between the claims and the references in stark contravention of the dictates of *Graham*. Accordingly, the Appellant respectfully requests that the Board grant the rehearing of claims 1 – 34 and reverse the Board decision sustaining the Appellee's rejections, under 35 U.S.C. § 103(a) of claims 1 – 34.

II. Conclusion

In light of the foregoing, Appellant respectfully requests that rehearing be granted under 37 C.F.R. § 41.52(a)(1) and that the Board reverse its decision sustaining the Appellee's rejection of claims 1 – 34. Appellant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 50715/P004US/10311738 from which the undersigned is authorized to draw.

Dated: May 18, 2009

Respectfully submitted,

By_____

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